

REMARKS

Applicants have amended the Title as required by the Examiner and have added a new claim 20 for the purpose of covering subject matter in which the data to be extracted includes the keyword in a part of the main body of the document file. Although claim 20 does not exclude the presence of characters or format characters in the extracted data, it does require that at least the keyword be present in such data.

Claims 1-4, 11, 12, 15, and 17-19 were rejected under 35 USC 103(a) on Gilbert in view of Kohler. Claims 5-10 were also rejected as unpatentable under 35 USC 103(a) over Gilbert in view of Kohler and Christensen. Applicants respectfully traverse these rejections.

The claimed invention allows a user to identify a keyword and a document file from which data corresponding to the keyword is extracted to be sent to a mail address. Gilbert only allows text to be *formatted* differently for individual email recipients. The only thing Gilbert has in common with the claimed invention is individualizing emails, which Gilbert does in a wholly different way for a wholly different purpose.

With respect to claim 1, the Examiner alleges that Gilbert discloses all of the claim limitations except for extracting data corresponding to the keyword, and that Gilbert's disclosed embedded processing code is equivalent to the claimed "keyword." To the contrary, Gilbert discloses embedded processing codes in email messages that are only text format codes used to *format text* within the email message for individual recipients. Gilbert's processing code is certainly not a "keyword," because it cannot and would not be used to search text in document files. The broadest reasonable interpretation of "keyword" does not include Gilbert's text format codes, which perform an entirely different function from keywords. Gilbert therefore does not disclose a keyword as claimed.

The Examiner admits that Gilbert does not disclose extracting data corresponding to the keyword from the document file, but contends that combining Gilbert with Kohler renders this

limitation obvious. Because Gilbert's embedded processing code is not a "keyword" as claimed, but rather a text formatting code, Gilbert cannot be combined with Kohler (even in hindsight) to arrive at the claimed invention, so the invention could not have been obvious. Furthermore, Kohler discloses that a user can send selected portions of text or attachments to identified email recipients, but does not disclose a keyword search through a document as claimed. Christensen does not address or remedy this deficiency.

To render a claim *prima facie* obvious, the cited references together must teach or suggest all of the limitations of the claim. MPEP 2143. Claims 1, 12, 15, and 17-19 recite a keyword, a document file, and extracting data corresponding to the keyword from the document file. Because the cited references do not teach or suggest a keyword used to extract data from a document file, no *prima facie* case of obviousness has been established, and the rejection under 35 USC 103(a) must be withdrawn. Claims 1, 12, 15, and 17-19 are allowable over the prior art of record. Claims 2-11 depend from claim 1 and are therefore allowable for the same reason.

In view of the above, each of the claims in this application is in condition for allowance.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952, referencing Attorney Docket No. 325772026100.

Dated: February 6, 2006

Respectfully submitted,

By 

Barry E. Bretschneider

Registration No. 28,055

MORRISON & FOERSTER LLP

1650 Tysons Blvd, Suite 300

McLean, Virginia 22102

Telephone: (703) 760-7743